



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/168,072	10/08/1998	NICK MARCHESANI	2413-101A	2085
24633	7590	02/08/2008		
HOGAN & HARTSON LLP IP GROUP, COLUMBIA SQUARE 555 THIRTEENTH STREET, N.W. WASHINGTON, DC 20004			EXAMINER PIERCE, WILLIAM M	
			ART UNIT 3711	PAPER NUMBER
			NOTIFICATION DATE 02/08/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dcptopatent@hhlaw.com

## Office Action Summary

### Application No.

09/168,072

### Applicant(s)

MARCHESANI, NICK

### Examiner

William M. Pierce

### Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.


### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

William Pierce  
Primary Ex 3711  


### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's affidavit filed 11/21/07 states his date of invention as early as 5/6/98 and provides evidence in exhibit A. The examiner questions the authenticity of this document since its body is type written and the first and last pages containing the dates are hand written and appear to have been appended to the document. However, exhibit C dated 8/5/1998 showing an attorney communication regarding their "Refernce: 2413-101" does no appear to be in question. This date is considered to establish an earlier effective date than 8/25/98 to Srichayaporn and the grounds for rejection has been removed.

### ***Claim Rejections - 35 USC § 103***

Claim 28, 31, 32, 33, 34, 37, 38, 39, 40 , 41, 43-47, 57, 59-361 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding 5,248,142 in view of Marquez 5,294,128.

As to claims 28, 33 and 57 Breeding shows a standard deck of cards (col. 4, ln. 33), dealing seven cards (as claimed from 3 to 7), each player making a single wager and placing a single wager prior to viewing cards (col. 5, ln. 13). In Breeding, he splits his cards into a two card and a five card hand and each hand must out rank the spit hands of the dealers. With respect to the number of cards in each hand to "not exceed the total number...by more than one, Marquez teaches in splitting six dealt cards into a one card high hand, two card high hand and three card low hand. He teaches that the number of cards and divided hands is "preferable" (col. 2, ln. 65). Here Marquez teaches that the number of cards and divided hands in a game like that of Breeding is

Art Unit: 3711

not critical. As such to have changed the number of cards dealt and in each divided hand of Breeding would have been obvious in order to make the game more manageable (Marquez, col. 2, ln. 67). The second difference in Breeding is how the winner is determined. While Breeding does not discuss the player LOW hand as being lower than the dealers, he does state that the lower hand must "win" or beat the dealer. From Marquez, we see that a known criteria to determine a winner in poker games is if the value of a hand is "lower". He discusses this with respect to "lo" poker (col. 1, ln. 22). To have used low poker criteria to determine a winner in a game like Breeding would have been obvious to have replaced one known method of resolving poker wagers for that of another. As with the instant invention where a player must win both the high hand and the low hand, the former according to "hi" poker and the latter according to "lo" poker, in Breeding a player must too win both hands. As such, changing the criteria used to determine the winner to another criteria known in poker does not change any of their respective functions and yields predictable results to one of ordinary skill in the art. Here each method of resolving a winner is known in the art of poker and the substitution of one known method for that of another yields predictable results. Applicant has not shown where his choice in resolving the winner of a hand in a pai gow type game using known "lo" poker methods produces any unexpected results. With respect to claims 31, 40, 41 and 43-45 as set forth above, the number of cards dealt is considered an obvious matter of choice. The discarding and drawing of cards in order to attempt to better ones chances of winner is old and well known to wagering card games like that of Breeding. As to claims 32, 34, 59 and 61, valuing 2 through 10

Art Unit: 3711

on their face value and face cards as 10 is well known. Additionally, valuing an ace as a 1 or 11 or either by choice of the player (as well known in black jack) is old to card games. This choice in ranking hands to be chosen by the casino is recognized by Marques (col. 3, ln. 8-30) and would have been obvious in Breeding although he fails to discuss them. The odds paid out by the house and its hold as called for by claim 37 is considered an obvious matter of choice. As to claims 38 and 60, Breeding shows that a player must lose both the front and back hands or it is declared a "push" (col. 5, ln. 3). As to claim 39, to designate a player a loser if one hand loses and the other ties in a game like Breeding would have been obvious order to make the game more favor the house. Applicant has not shown that anything more here is happening than what is expected. Evidence is that such is not critical since the opposite is previously set forth in claim 38. Player banking of a card game like that of Breeding as called for by claims 46 and 47 is old and well known to circumvent local regulations against house banked games.

Claim 29, 35, 36, 48, 49-56, 58 and 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding 5,248,142 in view of Marquez 5,294,128 and further in view of English 5,984,310 and Jones 6,206,374.

As to claim 29, 35, 48, 49, 58 and 62, Breeding and Marquez does not discuss a discard designed in his game. However, discarding and replacing cards is a well known feature in the play of poker games. English teaches that a player may discard and receive a replacement card for a fee (col. 3, ln. 63) in attempts to better their hands. To have included a discard design in a game of poker like that of Breeding would have

Art Unit: 3711

been obvious in order to give a player a chance to better his hand. The number of cards held and discarded as called for by claims 50-56 are considered an obvious matter of design choice. Such is not considered critical as evident by claims drawn to varying number of cards to be discarded. Breeding does not appear to discuss any dealer discard designs to the game. Jones teaches in poker having a dealer discard and draw following a predetermined procedure (col. 5, ln. 24). To have allowed a dealer to discard and draw according to predetermined criteria in a game like Breeding would have been obvious to allow the house to improve a dealer's chances of winning. As to claim 30, the Jones does not show the predetermined criteria allowing a dealer to draw to be three of a kind of cards valued 6-9. However, such a criteria is considered an obvious matter of design choice. A review of the specification on pg. 12 discusses this as merely being another "version" and fails to show where such is critical by solving any particular problem or producing any unexpected results. To have selected this criteria in a game like Breeding to allow for a dealer draw would have been obvious to change the game in an expected way with expected results. The replacement fee as called for by claim 35 is considered an obvious matter of choice for a casino.

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding 5,248,142 in view of Marquez 5,294,128 and further in view of Lo 5,863,042.

Breeding and the above do not discuss a player award for four of a kind. Lo teaches awarding a player for an initial deal of four of a kind in a pai gow type game like that of Breeding in order to give a player more opportunity to win.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*William Pierce*  
*Primary Ex 3711*